UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,793	04/18/2005	Richard Rabe	DC5174NP1	2244

7590 09/28/2007

Dow Corning Corporation
Patent Department C01232
Midland, MI 48686-0994

EXAMINER	
WOODWARD, ANA LUCRECIA	
ART UNIT	**PAPER NUMBER**
1711	
MAIL DATE	**DELIVERY MODE**
09/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/531,793	RABE ET AL.	
	Examiner	Art Unit	
	Ana L. Woodward	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 4/18/2005

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-12 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-10 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 4/18/05
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 3,553,282 (Holub).

Holub discloses compositions comprising (A) from 5 to 95 parts of a siloxane containing polyamide (reading on presently claimed component B) and (B) from 95 to 5 parts of a silicon free polyamide resin (reading on presently claimed component A). The siloxane containing polyamide is obtained by reacting a tetracarboxylic dianhydride with an aminoorganosiloxane.

The disclosure of the reference meets the requirements of the present claims both in terms of the types of materials added, their contents and process of making. The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

3. Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japanese 7-270803.

JP '803 discloses compositions for liquid crystal displays comprising an polyamide having an aliphatic structure of formula (1), reading on presently claimed component A, and a

silicone-modified polyamide of formula (2), reading on the presently claimed component B. See examples.

The disclosure of the reference meets the requirements of the present claims both in terms of the types of materials added, their contents and process of making. The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

4. Claims 1, 2 and 4-8 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 6,362,288 (Brewer et al).

Brewer et al disclose compositions comprising (A) a polyamide resin (reading on presently claimed component A), (B) a silicone base (not precluded from present claims), (C) a compatibilizer inclusive of siloxane-based polyamides having the formula per column 15, line 43 (reading on presently claimed component B) and additional (D) and (E) materials (not precluded from present claims). Examples B1 and B2 are noted of particular interest.

The disclosure of the reference meets the requirements of the present claims both in terms of the types of materials added, their contents and process of making. The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

As to the sheet requirement per claim 7, it would appear that the compression-molded product of the examples meets the sheet requirement.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 3,553,282 (Holub) described hereinabove.

It is within the scope of Holub to produce fibers from their invented compositions (column 6, line 64) thus meeting claim 9. As to claims 10-12, it is maintained that it would have been obvious to one having ordinary skill in the art to have produced fabrics, textiles and yarns from said fibers in accordance with the ultimate application desired. Accordingly, absent evidence of unusual or unexpected results, no patentability can be seen in the claimed subject matter.

7. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,362,288 (Brewer et al) in view of U.S. 3,553,282 (Holub), both described hereinabove.

With respect to the formation of fibers, it is maintained that it would have been obvious to one having ordinary skill in the art to have produced fibers from the compositions of Brewer et al given that Holub teaches the production of the same from similar-such compositions. As to claims 10-12, it is maintained that it would have been obvious to one having ordinary skill in the art to have produced fabrics, textiles and yarns from said fibers in accordance with the ultimate application desired. Accordingly, absent evidence of unusual or unexpected results, no patentability can be seen in the claimed subject matter.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,362,288 (Brewer et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims embrace compositions comprising (A) a polyamide resin (reading on presently claimed component A), (B) a silicone base (not precluded from present claims), (C) a compatibilizer inclusive of siloxane-based polyamides having the formula per column 15, line 43 (reading on presently claimed component B) and additional (D) and (E) materials (not precluded from present claims).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ana L. Woodward
Primary Examiner
Art Unit 1711